

Remarks

Reconsideration of this Application is respectfully requested.

Status of the Application and Claims

Upon entry of the foregoing amendments, claims 1-13, 23-27, 29-35, 37-50, and 52-56 are pending in the application, with claims 1, 6, 7, 9-13, 23, 26, 27, and 29 being the independent claims. Claims 14-22 previously were cancelled without prejudice to or disclaimer of the subject matter recited therein. Claims 46 and 51 are cancelled herein without prejudice to or disclaimer of the subject matter recited therein. Claims 1, 5-13, 23, 26, 27, 29, 36-41, 44, 47-50, 52, and 53 are amended herein. Claims 54-56 are newly presented. No new matter has been added.

Summary of Office Action

In the Office Action, claims 1-13, 23-27, 29-53 were rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over U.S. Patent No. 5,311,591 (Fischer). Claims 1-13, 23-27, 29-53 further were rejected under the judicially created doctrine of non-statutory obviousness-type double patenting, as allegedly being unpatentable over claims 1-25 of parent U.S. Patent No. 6,671,718 (Meister).

Reconsideration and withdrawal of the rejections respectfully are requested in view of the above amendments and the following remarks.

Summary of Examiner Interviews

Applicants' attorney gratefully acknowledges the courtesies extended to him by the Examiner in granting telephone interviews on or about October 7, 2009, and December 29, 2009.

In the October 2009 telephone interview, Applicants' attorneys requested clarification of the stated basis for the rejection of claims 2-5 set forth in the Office Action. The Examiner confirmed that the stated basis should refer to "an unauthorized agent." The Examiner also confirmed that the statement at page 6 of the Office Action ("The *references* are cited in the Form PTO-892 for the applicant's view."; emphasis added) refers to newly cited U.S. Patent 5,311,591 (Fischer) alone; no further references are cited.

In the December 29 telephone interview, Applicants' attorney discussed features of the claims, including the features of a user interface configured to receive as input an instruction for further processing or disposition of an *unauthorized* electronic mail message, e.g., to selectively modify the unauthorized electronic mail message, cancel transmission of the unauthorized electronic mail message, or authorize transmission of the unauthorized electronic mail message (see, e.g., prior-presented dependent claim 8). Applicants' attorney presented arguments distinguishing these features over the Fischer '591 patent. The Examiner tentatively acknowledged (subject to further review) that the Fischer '591 patent fails to teach the feature of providing, in response to recognition of an unauthorized electronic mail message about to be sent, a user interface configured to receive as input an instruction for further processing of the unauthorized electronic mail message. The Examiner stated that he believes it was known at the time of the invention to present a user with a "confirm transaction" button, e.g., to confirm a selected stock trade. Applicants' attorney noted that such allegedly prior known functionality relates to confirmation of an authorized transaction prepared immediately prior thereto by a user his/her-self, rather than to an unauthorized transaction, e.g., prepared by an unauthorized agent, such as a virus. The

Examiner agreed to further consider the proposed claim amendments upon the filing of a formal written reply to the office action.

Rejection Under 35 U.S.C. 103

The rejection of claims 1-13, 23-27, 29-53 under 35 U.S.C. § 103(a), as allegedly being unpatentable over U.S. Patent No. 5,311,591 (Fischer), respectfully is traversed. Nevertheless, without conceding the propriety of the rejection, claims 46 and 51 have been cancelled without prejudice to or disclaimer of the subject matter recited therein, and claims 1, 5-13, 23, 26, 27, 29, 36-41, 44, 47-50, 52, and 53 have been amended herein more clearly to recite various features of the claims, with particular attention to the Examiner's comments in the Office Action and the telephone interviews. Support for the amendments may be found throughout the original application, e.g., in Figs. 2 and 4, and the corresponding written disclosure at paragraph no. [0028]. These features also find support in prior-filed claims, e.g., claim 8. No new matter has been added.

Applicants submit that there are differences between the subject matter sought to be patented and the prior art, such that the subject matter taken as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. § 103. In particular, Applicants submit that the cited Fischer '591 patent fails to disclose or suggest each and every element of the claims.

In one aspect, independent claim 1 recites (emphasis added):

An e-mail method, comprising:

recognizing that an unauthorized electronic mail message is about to be sent from a computing device configured to send an electronic mail message; and

providing at the computing device an alert indicating that the unauthorized electronic mail message is about to be sent from the computing device, the alert being provided by a user interface configured to receive as input an instruction for further processing of the unauthorized electronic mail message.

Independent claims 9-13, 23, 26, 27, and 29 variously recite similar features with respect to a method (claims 11-13, 23, 26, and 27), an apparatus (claims 9 and 29 (means-plus-function format under 35 U.S.C. § 112, 6th paragraph)), and an article of manufacture including a computer-readable storage medium (claims 10 and 29).

In a similar aspect, independent claim 11 recites (emphasis added):

An electronic mail message alert display, comprising:

a text display configured to provide an alert indicating that an unauthorized electronic mail message is about to be sent and to display at least information relating to an addressee of the unauthorized electronic mail message; and

a user interface configured to receive as input an instruction that stops transmission of the unauthorized electronic mail message.

In another similar aspect, independent claim 6 recites (emphasis added):

An e-mail method, comprising:

recognizing that an unauthorized electronic mail message is about to be sent from a computing device configured to send an electronic mail message;

displaying at least information relating to an addressee of the unauthorized electronic mail message in a user interface configured to receive as input an instruction to stop transmission of the unauthorized electronic mail message; and

stopping transmission of the unauthorized electronic mail message in response to the instruction input via the user interface.

In another similar aspect, independent claim 7 recites (emphasis added):

An e-mail method, comprising:

recognizing that an unauthorized electronic mail message is about to be sent from a computing device configured to send an electronic mail message;

displaying at least information relating to an addressee of the unauthorized electronic mail message in an interactive user interface configured to receive as input an instruction to delete the unauthorized electronic mail message; and

deleting the unauthorized electronic mail message, prior to transmission of the unauthorized electronic mail message, in response to the instruction input via the user interface.

The Fischer '591 patent fails to disclose or suggest at least the above-recited features of *the alert being provided by a user interface configured to receive as input an instruction for further processing of the unauthorized electronic mail message* (claims 1, 9, 10, 12, 13, 23, 26, 27, and 29), or *stopping transmission of the unauthorized electronic mail message in response to the instruction input from the user interface* (claim 6), or *deleting the unauthorized electronic mail message, prior to transmission of the unauthorized electronic mail message, in response to the instruction input via the user interface* (claim 7), or *a user interface configured to receive as input an instruction to stop transmission of the unauthorized electronic mail message* (claim 11), as disclosed in the present application and variously recited in the claims.

At page 3 of the Office Action, with respect to the features recited in prior pending dependent claim 8, the Examiner asserts:

Fischer discloses displaying the unauthorized electronic mail message in an interface configured to input an instruction to modify the unauthorized electronic mail message, cancel transmission of the unauthorized electronic mail (e.g., see column 3 (lines 12-59), column 4 (lines 61-68), and column 19 (lines 20-48)).

Applicants respectfully disagree.

In fact, in comments at page 5 of the Office Action, referring to the above cited portions of the Fischer '591 patent, the Examiner acknowledges that "Fischer might not mention [an alert] exactly as claimed" but asserts "Fischer clearly discloses the *gist* of the invention" (emphasis added). Specifically, the Examiner states (emphasis added):

While Fischer clearly discloses the gist of the invention as described above, Fischer might not mention [sic] exactly as claimed. For example, Fisher [sic] might not exactly mention "an alert indicating that the unauthorized electronic mail message is about to be sent". Instead, *Fisher [sic] mentions an error code or a message is generated to indicate that the electronic mail function is denied. Clearly Fischer discloses PAI is checked to make sure that it is authorized to perform electronic mail function and to ensure that the programs do not defected [sic] with virus. Thus, it would have been obvious to one of ordinary skill in the art to recognize that the teaching of Fischer is the same as claimed*

language because Fisher [sic] clearly discloses the error message (alert) is generated when the electronic mail function is denied (unauthorized function).

Without conceding the propriety of the Examiner's characterizations of the Fischer '591 patent disclosure, Applicants submit that *such alleged disclosure* of the "gist of the invention" is legally insufficient to support the stated rejection.

The Fischer '591 patent states at column 3, lines 12-59 (emphasis added):

In one contemplated embodiment of the present invention, programs may be part of data objects, which are written in a high-level control language and are executed by a standardized interpreter program which executes this high-level control language and are executed by a standardized interpreter program which executes this high-level language. In this case, ***part of the interpreter's task is to verify that the functions encountered in the high-level logic are, in fact, permissible. If such tasks are not permissible, the interpreter then suppresses the execution of the program not authorized to perform such tasks.***

Many advantages flow from the use of the present invention. For example, *the present invention advantageously serves to bind limitations to programs so that it becomes impossible for covert programs or viruses to be introduced into the system. Users are protected through specifying details as to the functions that may be performed to ensure that programs which are intended for one function do not accidentally or intentionally cross-over and affect other unrelated or critical resources (so as to effect the spread of computer viruses).* Through the use of the program authorization information in the manner described herein, it is possible for users to protect themselves against the programs they execute.

Administrative agents can effectively limit the scope of programs without the need to comprehend every aspect of the program's logic. Administrators can authorize and limit programs based on their intended functions and definitions to thereby reduce the dangers of program defects. In this fashion, the dangers of the distraught or mischievous programmer who might try to plant a software "time bomb" or virus can be limited.

The present invention also permits digital signatures to verify the PAI. Thus, programs can be freely and safely exchanged within a large population, where all members trust the common high-level signing authority.

Even programs with no known trustworthiness can be used after program authorization information associates a wide range of restrictions to thereby allow potentially beneficial programs to be safely used -- even if they do not have an official certification of trust.

The present invention also allows an unlimited number of different resources and functions to be controlled. For example, ***some useful resources/functions which may be controlled include:*** the ability to limit a program to certain files or data sets; ***the ability to transmit data via electronic mail to someone outside the user's domain;*** the ability of a

program to create or solicit digital signatures; the ability to limit access to a program of certain security classes, etc.

The Fischer '591 patent states at column 4, lines 61-68:

Each terminal is capable of generating a message performing whatever digital signature operation may be required and transmitting the message to any of the other terminals connected to communications channel 12 (or a communications network (not shown), which may be connected to communications channel 12). The terminals A, B ... N are also capable of performing signature verification on each message as required.

The Fischer '591 patent states at column 19, lines 14-48 (emphasis added):

Additionally, in block 340, an examination is made of the PAI information stored in the process control block. *As a follow up to, or associated with, the processing in block 340, a check is made in block 342 to determine whether the examined PAI is allowed access to the required resources or allowed to perform the required functions. For example, if an attempt is made to use electronic mail, a check is made of the PAI to determine whether the program is authorized to perform electronic mail functions and if so whether the mailing is limited to a set of mail identifiers.*

If the check at 342 reveals that the PAI does not allow the attempted function or resource access, then a error message is generated in block 344 to indicate that the program is attempting to exceed its limits, access to the resource or function is denied and an appropriate error code or message is generated. A check is then made in block 350 to determine whether the program attempting to achieve access should be informed that it has been denied access (350). If the check in block 350 reveals that the program should be so informed, then in block 352, the program is allowed to resume execution with a message indicating the type of access violation that caused the request to fail and be suppressed. The routine then branches back to block 336 for resuming execution of the program. Under such circumstances, the program may be informed, for example, that its PAI is only authorized to read authority for a particular file whereas an attempt was made to write to that file. If the check at block 350 indicates that the calling program should not be informed, then appropriate status and related messages (for the calling program) are generated indicating termination due to an unspecified access violation 356.

Nowhere in these cited passages, or anywhere else, does the Fischer '591 patent disclose or suggest at least the features of *the alert being provided by a user interface configured to receive as input an instruction for further processing of an unauthorized electronic mail message* (claims 1, 9, 10, 12, 13, 23, 26, 27, and 29), or *stopping transmission*

of the unauthorized electronic mail message in response to the instruction input in the user interface (claim 6), or deleting the unauthorized electronic mail message, prior to transmission of the unauthorized electronic mail message, in response to the instruction input via the user interface (claim 7), or a user interface configured to receive as input an instruction to stop transmission of the unauthorized electronic mail message (claim 11), as disclosed in the present application and variously recited in the claims. Rather, the Fischer '591 patent teaches generating and providing to the requesting program an error message or code in response to a determination that the requesting program is operating outside of its authorized functionality. The Examiner has not provided any rational basis why the above-recited combination of features of the claims (including, e.g., providing an alert indicating that an unauthorized electronic mail message is about to be sent from the computing device, the alert being provided by a user interface configured to receive as input an instruction for further processing of the unauthorized electronic mail message) would have been obvious to one of ordinary in the art based on the above disclosure, or any other disclosure, of the Fischer '591 patent. And Applicants submit there is none.

For the above reasons, independent claims 1, 6, 7, 9, 10, 11, 12, 13, 23, 26, and 29 are allowable over the Fischer '591 patent.

Claims 2-8, 24, 25, 30-45, 47-50, and 52-56 respectively depend directly or indirectly from independent claims 1, 6, 7, 9, 10, 11, 12, 13, 23, 26, and 29, and are allowable for the same reasons. Moreover, each of these dependent claims recites additional features in combination with the features of its respective base claim and is believed allowable in its own right. In this regard, newly presented claims 54-56 depend from claim 1, and have been added to provide Applicants with additional scope of coverage commensurate with the

disclosure. Support for these claims may be found throughout the original application, e.g., in Figs. 2 and 4 and the corresponding written disclosure. No new matter has been added. Individual consideration of the dependent claims respectfully is requested.

Non-Statutory Double Patenting Rejection

Applicants acknowledge the provisional rejection of claims 1-13, 23-27, 29-53 under the judicially created doctrine of non-statutory obviousness-type double patenting, as allegedly being unpatentable over claims 1-25 of parent U.S. Patent No. 6,671,718 (Meister). Without conceding the propriety of the rejection, Applicants respectfully request that the rejection, and any requirement to file a terminal disclaimer, be held in abeyance until the application is indicated to include allowable claims and it may be determined if any of such allowable claims properly may be rejected under such a double patenting rejection.

Formal Matter

By separate paper filed concurrently herewith, Applicants have filed an Information Disclosure Statement (IDS) identifying additional information that may be deemed pertinent to the present application. The Examiner is invited to review the information cited therein, and is requested to provide Applicants' attorney with an initialed copy of the IDS form, with the next official communication, indicating that the information has been entered and considered on the merits.

Conclusion

Applicants believe that the present Amendment and Reply is responsive to each of the points raised by the Examiner in the Office Action and the telephone interviews, and submit that the application and claims are in condition for allowance. Favorable consideration of the claims and passage to issue of the application at the Examiner's earliest convenience earnestly are solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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